



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/378,533

08/20/1999

PAMELA L. MCKISSICK

UV-98

9255

75563

7590

07/17/2009

ROPES & GRAY LLP

PATENT DOCKETING 39/361

1211 AVENUE OF THE AMERICAS

NEW YORK, NY 10036-8704

EXAMINER

HUYNH, SON P

ART UNIT

PAPER NUMBER

2424

MAIL DATE

DELIVERY MODE

07/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/378,533	Applicant(s) MCKISSICK ET AL.	
	Examiner SON P. HUYNH	Art Unit 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 63-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 63-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/29/2009 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 63-86 have been considered but are moot in view of the new ground(s) of rejection.

With respect to Applicant's argument about distinguishes between notification and reminders (page 8, paragraph 2), it is noted claim 67 recites "wherein providing a notification includes providing a reminder notification". Thus, it appears that the reminder (or reminder notification) could be interpreted as "notification" as recited in the claim.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 63-68 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of *In Re Bilski* 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The claimed method comprising displaying..., is broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent. For example, the displaying a list... could be performed by displaying a list... on a piece of paper, user select a program title could be performed by using a pen/fingers or communicate with another person at the same location or via mail.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2424

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 63-64, 66-72, 74-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al. (US 5,351,075) in view of Williams et al. (US 5,945,988).

Regarding claims 63, 69, 77, and 82, Herz teaches a dynamic scheduling system and method that receives user votes for movies to adjust the prime-time viewing periods (col. 3, lines 27-53). Herz teaches displaying a list of a plurality of program titles, wherein each of the plurality of program titles is for an unscheduled program that is outside a program listings time frame that is currently available to a user (see include, but not limited to, col. 5, lines 36-41, lines 60-63);

displaying information with the plurality of program titles, wherein the information informs the user that the unscheduled programs are outside the program listings time frame that is currently available to the user and informs the user that the unscheduled programs are expected to be available at a later time (lists of includes information derived from video magazines discloses upcoming releases, and date of the release - see include, but not limited to, col. 5, lines 60-63). Herz teaches providing the user with the opportunity to select a program title from the displayed list of the plurality of program titles (col. 5, lines 30-50), and providing a notification to the user of the availability of the program corresponding to the selected program title when the program is available in the program listings time frame in form of program guides (col. 6, lines 34-35). However, Herz is silent about displaying a program-specific availability notification to the user

Art Unit: 2424

indicating the availability of the program corresponding to selected program title in response to the listing of the program corresponding to the selected program title in the current program listing time frame.

Williams discloses providing and displaying a program-specific availability notification to the user indicating the availability of the program corresponding to the selected program title in response to the listing of the program corresponding to the selected program title in the current program listing time frame (prompting the user or displaying a list of program suggestions to user with the found information by searching updated programming information indicating the availability of the program corresponding to selected program title or keywords corresponding to the requested title or keywords in the current program listing time frame selected by user - see include, but not limited to, col. 6, lines 8-64, col. 7, lines 14-62, col. 11, line 1-col. 12, line 14, col. 15, lines 11-25, figures 6-8); the unscheduled program is also read on program with information received in update programming information, or program that is not currently displayed on the program guide screen). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Herz with the teaching as taught by Williams in order to yield predictable results such as to allow user to locate desired content easily or to avoid missing content that is interest to current system user.

Regarding claim 64, Herz in view of Williams discloses the method as discussed in the rejection of claim 63. Williams further discloses displaying a list of programs for which a

Art Unit: 2424

notification is to be provided (e.g., displaying a list of programming suggestions or prompts the user with the found program information - see include, but not limited to, col. 11, line 9-col. 12, line 14).

Regarding claim 66, Herz in view of Williams discloses the method as discussed in the rejection of claim 63. Williams further discloses providing a notification includes providing a message notification (message notification is read on program suggestions or prompts the user with the found information - see include, but not limited to, col. 11, line 9-col. 12, line 14, col. 15, lines 11-25).

Regarding claim 67, Herz in view of Williams discloses the method as discussed in the rejection of claim 63. Williams further discloses providing a notification includes providing a reminder notification (message notification is read on program suggestions or prompts the user with the found information - see include, but not limited to, col. 11, line 9-col. 12, line 14, col. 15, lines 11-25).

Regarding claim 68, Herz in view of Williams discloses the method as discussed in the rejection of claim 63. Williams further discloses providing a user with the opportunity to setup a configuration of the notification (interpreted as user selected a request, keyword, title, etc. to setup a configuration of notification for this selections, and when the selected keyword, title, etc. is detected, prompt reminder or suggestion - see

Art Unit: 2424

include, but not limited to, col. 7, lines 41-62, col. 11, line 9-col. 12, line 14, col. 15, lines 11-25).

Regarding claims 72, 74-76, 78-81, 83-86, the additional limitations that respectively correspond to the additional limitations of claims 64, 66-68 are analyzed as discussed in the rejection of claims 64, 66-68.

Regarding claim 70, Herz in view of Williams discloses the method as discussed in the rejection of claim 69. Herz in view of Williams further teaches user television equipment (Herz: figure 1, labels 40 and 50; Williams: figure 1, 5).

Regarding claim 71, Herz in view of Williams discloses the method as discussed in the rejection of claim 69. Herz in view of Williams further teaches user equipment is user personal computer equipment (Williams: figure 1, 5, col. 3, lines 16-28). It would have been obvious to one of ordinary skill in the art to modify Herz by using a personal computer as further taught by Williams in order to enable different devices to interface with the system.

7. Claims 65, 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al. (US 5,351,075) in view of Williams et al. (US 5,945,988) as applied to claim 63 or claim 69 and further in view of Menard et al. (US 6,061,056).

Art Unit: 2424

Regarding claim 65, Herz in view of Williams discloses the method as discussed in the rejection of claim 63. Herz in view of Williams does not explicitly disclose providing a notification including providing an e-mail notification.

Menard discloses providing a notification including providing an email notification or a message notification (see include, but not limited to, col. 2, lines 27-41, col. 5, lines 51-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Herz in view of Williams with the teaching as taught by Menard in order to yield predictable results such as to delivery notifications to any Internet accessible system.

Regarding claim 73, the additional limitations that correspond to the additional limitations of claim 65 are analyzed as discussed with respect to the rejection of claim 65.

8. Claims 63-64, 67-72, 75-78, 80-83, 85-86 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al. (US 5,351,075) in view of Schein et al. (US 6,133,909).

Regarding claims 63, 69, 77, and 82, Herz teaches a dynamic scheduling system and method that receives user votes for movies to adjust the prime-time viewing periods (col. 3, lines 27-53). Herz teaches displaying a list of a plurality of program titles,

Art Unit: 2424

wherein each of the plurality of program titles is for an unscheduled program that is outside a program listings time frame that is currently available to a user (see include, but not limited to, col. 5, lines 36-41, lines 60-63);

displaying information with the plurality of program titles, wherein the information informs the user that the unscheduled programs are outside the program listings time frame that is currently available to the user and informs the user that the unscheduled programs are expected to be available at a later time (lists of includes information derived from video magazines discloses upcoming releases, and date of the release - see include, but not limited to, col. 5, lines 60-63). Herz teaches providing the user with the opportunity to select a program title from the displayed list of the plurality of program titles (col. 5, lines 30-50), and providing a notification to the user of the availability of the program corresponding to the selected program title when the program is available in the program listings time frame in form of program guides (col. 6, lines 34-35). However, Herz is silent about displaying a program-specific availability notification to the user indicating the availability of the program corresponding to selected program title in response to the listing of the program corresponding to the selected program title in the current program listing time frame.

Schein discloses providing and displaying a program-specific availability notification to the user indicating the availability of the program corresponding to the selected program title in response to the listing of the program corresponding to the selected program title in the current program listing time frame (see include, but not limited to, col. 11, lines

Art Unit: 2424

62-65, col. 12, line 34-col. 14, line 9; the unscheduled program is also read on future episodes of series associated with title selected by user from program listing or program that is not currently displayed on the program guide screen). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Herz with the teaching as taught by Schein in order to yield predictable results such as to allow user to locate desired content easily or to avoid missing content that is interest to current system user.

Regarding claim 64, Herz in view of Schein discloses the method as discussed in the rejection of claim 63. Schein further discloses displaying a list of programs for which a notification is to be provided (notifying the user when desired program(s) has/have been located see include, but not limited to, col. 13, lines 34-col. 14, line 9).

Regarding claim 67, Herz in view of Schein discloses the method as discussed in the rejection of claim 63. Schein further discloses providing a notification includes providing a reminder notification (col. 12, lines 57-65, col. 13, lines 45-48, col. 13, line 61-col. 14, line 9).

Regarding claim 68, Herz in view of Schein discloses the method as discussed in the rejection of claim 63. Schein further discloses providing a user with the opportunity to setup a configuration of the notification (interpreted as user selection of a request, keyword, title, etc. to setup a configuration of notification for this selections, and when

Art Unit: 2424

the selected keyword, title, etc. is detected, prompt reminder/notify user- see include, but not limited to, col. 11, line 63-col. 14, line 9).

Regarding claim 70, Herz in view of Schein discloses the method as discussed in the rejection of claim 69. Herz in view of Schein further teaches user television equipment (Herz: figure 1, labels 40 and 50; Schein: figure 1).

Regarding claim 71, Herz in view of Schein discloses the method as discussed in the rejection of claim 69. Herz in view of Schein further teaches user equipment is user personal computer equipment (Schein: figure 1, 3). It would have been obvious to one of ordinary skill in the art to modify Herz by using a personal computer as further taught by Schein in order to enable different devices to interface with the system.

Regarding claims 72, 75-76, 78, 80-81, 83, 85-86, the additional limitations that respectively correspond to the additional limitations of claims 64, 67-68 are analyzed as discussed in the rejection of claims 64, 67-68.

9. Claims 65-66, 73-74, 79, 84 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al. (US 5,351,075) in view of Schein et al. (US 5,945,988) as applied to claim 63 or claim 69 and further in view of Menard et al. (US 6,061,056).

Art Unit: 2424

Regarding claims 65-66, Herz in view of Schein discloses the method as discussed in the rejection of claim 63. Herz in view of Schein does not explicitly disclose providing a notification including providing an e-mail notification or message notification.

Menard discloses providing a notification including providing an email notification or a message notification (see include, but not limited to, col. 2, lines 27-41, col. 5, lines 51-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Herz in view of Williams with the teaching as taught by Menard in order to yield predictable results such as to delivery notifications to any Internet accessible system.

Regarding claim 73-74, 79, and 84, the additional limitations that correspond to the additional limitations of claims 65-66 are analyzed as discussed with respect to the rejection of claims 65-66.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Maze et al. (US 6,216,264) discloses scheduler apparatus employing a gopher agent .

Robarts et al. (US 2005/0278741 A1) discloses query based electronic program guide comprises searching unscheduled programs and notifying viewer (paragraph 0097).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SON P. HUYNH whose telephone number is (571)272-7295. The examiner can normally be reached on 9:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Son P Huynh/
Primary Examiner, Art Unit 2424

July 13, 2009

Application/Control Number: 09/378,533
Art Unit: 2424

Page 14